REMARKS

Provisional Election

In the March 3, 2006 Office Action all outstanding rejections have been withdrawn and restriction has been required between Group I, claims 1-12 and 15-23, and Group II, claims 14-15. Subject to the traversal grounds stated below, the applicant provisionally elects Group II, claims 13-14.

Grounds for Traverse

In the March 3, 2006 Office Action the outstanding rejections have been withdrawn, and restriction imposed, in reply to the Applicant's Brief, filed Feb, 17, 2005. Such an action is unprecedented, contrary to USPTO regulations and unauthorized.

The March 3, 2006 Action cites no authority for issuing a restriction requirement after an appeal has been taken where no new claims have been submitted by the Applicant. In the undersigned's more than 25 years of practice before the USPTO, such an Action has never been encountered. It is submitted that the Action has no precedent and as such constitutes arbitrary and capricious action under the Administrative Procedure Act.

Further, restriction in this case is clearly untimely under established USPTO regulation. Restriction is authorized ***before*** Final Action. 37 CFR 1.142(a). This case has gone past Final Action to an Appeal. That fact cannot be ignored merely by conceding the Appeal. Reopening prosecution after Appeal to impose a restriction requirement directly violates §1.142(a) because the status of this case is not before Final Action. Note that even if the restriction would have been proper on the merits prior to Final Action, imposition is always a matter of discretion. 35 U.S.C. 121 states:

> If two or more independent and distinct inventions are claimed in one application, the Director ***may*** require the application to be restricted to one of the inventions. ... The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention." (emphasis added).

Therefore it cannot be argued that late imposition of restriction after Final Action is necessary to effect an overriding public policy in limiting patents to a single invention.

It is also noted that imposition of restriction in this case constitutes a reopening of prosecution after an appeal has been taken. In order to reopen prosecution after appeal, approval of the supervisory Examiner is required. MPEP 1207.04. Nothing in the Action indicates that such approval has been obtained. Furthermore, in view of the fact that ***all*** outstanding grounds for rejection have been withdrawn in response to the Appeal Brief, it is submitted that the burden to reopen prosecution in this case is even higher. The Appeal has been conceded and so should be treated by the Examiner as a ***judgment by the Board***. That is, since no grounds of rejection have been maintained the application's procedural status should be equivalent to a decision by the Board reversing the Examiner. See MPEP 1214.04. In order to reopen prosecution after Board decision, authorization of the Technology Center (TC) Director is required. It is submitted that the same level of review should have been applied here.

Finally, it is noted that the inventions of the two Groups have already been searched and actions thereon have been given. Restriction at this time is not necessary to the provision of a complete Examination.

At least for the reasons that Restriction at this point in prosecution is unprecedented, is untimely in view of 37 CFR 1.142(a), has not been properly authorized and is unnecessary, reconsideration and withdrawal of the requirement is respectfully requested.

The outstanding rejections have been overcome. The requirement for restriction should be withdrawn and the application should be passed to issue without further delay.

Conclusion

In view of the foregoing it is believed that the present application, with claims 13-14 is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

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